

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

)	
)	Decision on
In re)	Petition for Regrade
)	Under 37 C.F.R. § 10.7(c)
_____)	

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 2, 20, 26, 30, 41 and 43 of the morning section of the Registration Examination held on August 26, 1998. The petition is denied to the extent that Petitioner seeks a passing score for the morning section of the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 60 on the morning section. On December 28, 1998, Petitioner requested regrading of six two-point questions on the morning section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner's arguments have been considered, but lack merit. For the following reasons, two points will be added to Petitioner's score for the afternoon section of the Examination.

Question 2 reads as follows:

2. Your client, Mr. Jones, asked you to prepare a patent application for his new pasta maker. The key features of the invention are the different types of dough which can be used and the shapes of the pasta which can be made. The completed application was filed on Monday, May 18, 1998. After filing the application, you conducted a prior art search and found a published article by another which was published on May 16, 1997. The published article discusses a pasta maker very similar to your client's pasta maker. In the course of your search, you also found a few patents, but none as pertinent as the article. You file all of the prior art in an Information Disclosure Statement on June 8, 1998. In your opinion, the article is the best available prior art. Assuming that this is true, under which of the following sections of Title 35 U.S.C., if any, would Mr. Jones not be entitled to a U.S. patent?

- (A) 102(a)
- (B) 102(b)
- (C) 102(d)
- (D) 102(e)
- (E) None of the above.

Choices (A) and (E) are correct answers. Petitioner selected answer (B). Both (A) and (E) are considered correct answers in light of the statement that the "published article discusses a pasta maker very similar to your client's pasta maker." As explained in MPEP § 706.02, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." The phrase "very similar" can be understood to mean that the published article explicitly or impliedly discloses every aspect of the claimed invention. Under this interpretation, (A) is correct because the published article is prior art under 35 U.S.C. § 102(a) (used to reject claims to an invention that "was known . . . by others in this country, or . . . described in a printed publication in this . . . country, before the invention thereof by the applicant for patent").

The phrase “very similar” could also be taken to mean that the published article did not teach every aspect of the claimed invention as required for anticipation under 35 U.S.C. § 102. Based on this interpretation, answers (A), (B), (C), and (D) would be rendered incorrect because they are all based on sections of 35 U.S.C. § 102. Accordingly, answer (E) “[n]one of the above,” is also a correct answer.

Answer (B) is not a correct answer because of when the one year anniversary date occurs for the published article and when the patent application needs to be filed.

“When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken or the fee paid, on the next succeeding secular or business day.” 35 U.S.C. § 21(b). This statute modifies the one year or twelve month periods specified in other parts of Title 35 including 35 U.S.C. § 102(b). See MPEP § 2133. Therefore, the article would be a reference under 35 U.S.C. § 102(a) and not under § 102(b), since May 16, 1998, falls on a Saturday. *Ex parte Olah*, 131 USPQ 41, 43 (Bd. App. 1960).

Petitioner argues that the question and answers are inherently ambiguous because the facts did not provide the date of invention for the claimed invention, and therefore it was impossible to determine whether 35 U.S.C. § 102(a) prevented patenting. However, the question inquires which section of 35 U.S.C., if any, would prohibit the applicant from obtaining a patent. On the stated facts, either the article is available as prior art under 35 U.S.C. § 102(a), as set forth in answer (A) or, because of the other plausible interpretation given to the phrase “very similar,” answer (E), “none of the above” is a correct answer. Knowing the date of invention was not part of the fact pattern and the

Examination instructions expressly warn examinees to “not assume any additional facts not presented in the questions.”

Petitioner also argues that it was impossible to determine whether the “very similar” article was sufficient to anticipate the claims. However, as discussed above, two acceptable interpretations may be given to the phrase “very similar,” and therefore both answers (A) and (E) are correct. Thus, contrary to Petitioner’s argument, it was possible to determine that either the “very similar” prior art precluded a patent under 35 U.S.C. § 102(a) or the “very similar” prior art may have rendered the claimed invention obvious, thereby making answer (E) a correct choice.

Petitioner additionally argues that he chose (B), which recites section 102(b), because it was the closest statutory section in terms of analysis to section 102(a) with regard to rendering the claim invalid. Contrary to Petitioner’s argument, however, the closest statutory section to section 102(a) is in fact section 102(a), as opposed to section 102(b). This argument by Petitioner is simply unpersuasive. Accordingly, in view of the above, no grading error has been shown.

Question 20:

Two points are awarded for question 20.

Question 26 reads as follows:

26. The claimed invention in inventor Jones' application is a digital transmission system which communicates a plurality of separate digital streams over a common channel. It includes a transmitter portion (block encoding arrangements and multiplexer), and receiver portion (a demultiplexer and block decoding arrangements). The receiver portion includes a phase comparator having four inputs and one output and a divider having two inputs and one output. The functions of the phase comparator and divider are adequately disclosed in the specification. However, the specification does not describe how to make and use the phase comparator and divider. The examiner correctly and reasonably asserting that the comparator was not a typical two input phase comparator, and the divider was not a typical one input divider, properly rejected the claims under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed. Which of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure?

- (A) A declaration of a professor stating that "the elements referred to in the application as the divider and the phrase [sic, phase] comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application.
- (B) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, and that these elements were "routinely built."
- (C) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built," and the professor provides details in the declaration concerning the structure and function of the elements.
- (D) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university."

- (E) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, that these elements were “routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The professor was involved with the construction of the digital transmission system.

Both (C) and (D) are accepted as correct answers and Petitioner selected answer (A). The question asks which of five declarations would be minimally legally sufficient to overcome the examiner’s rejection in accordance with proper PTO practice and procedure. The declarations in both answer (C) and answer (D) state that the divider and phase comparator were “well-known to those of skill in the art as of June 17, 1997” and that these elements were “routinely built.” Answer (C) also states that the declarant “provides details in the declaration concerning the structure and function of the elements.” Choice (C) contains additional “details” so as to constitute “something more than a conclusory statement” as referred to in MPEP § 2164.05. Providing these details in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. See fact pattern to question (“the claims [stand rejected] under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed”) (emphasis added).

As such, credit has been given for answer (C). As explained in MPEP § 2164.05, “[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement.” *See also In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)

(“expert’s opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement”).

The declaration in (D) states that these elements were “sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The factual evidence in (D) demonstrates that the divider and phase comparator were well known to those skilled in the art as of the filing date of the application. Again, having this statement in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. For these reasons, (D) is a correct answer. A specification need not disclose what is well known to those skilled in the art and may omit that which is well known to those skilled and already available to the public. See MPEP § 2164.05(a), citing *In re Buchner*, 929 F.2d at 661, 18 USPQ2d at 1332; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

Answer (A) is not correct because a conclusory statement by an expert on the ultimate legal conclusion of obviousness is insufficient to show nonobviousness. *See Buchner*, 929 F.2d at 661, 18 USPQ2d at 1332 (“expert’s opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement”). As stated in MPEP § 2164.05, “[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement.” Additionally, what answer (A) also lacks is a declaration which includes a direct answer to the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device.

In sharp contrast, the declarations in answers (C) and (D) do not lack this direct response to the examiner's concern.

Petitioner argues that the answers to this question were ambiguous because it was unclear whether statements in the answers consisted of the entirety of the declaration or just a description of the statements in that certain statements appeared in quotes and others did not. However, no ambiguity is apparent as a result of some statements being in quotes and others not being in quotes. Obviously, statements in quotes are to be found in the declaration. The statements not in quotes are statements of fact regarding the content of the declaration or other surrounding facts.

Petitioner also argues that he found it impossible to determine whether other unrecited facts existed to support the statements in the answers. However, the examination instructions expressly warn to "not assume any additional facts not presented in the questions." Accordingly, Petitioner's argument is directly contrary to the instructions. In view of the above, no grading error has been shown.

Question 30 reads as follows:

30. Inventor X, a citizen of Germany, invented a tape dispenser in Germany on May 5, 1996. On January 22, 1997, X filed a patent application for the tape dispenser in the German Patent Office. On January 22, 1998, you filed a complete U.S. patent application in the PTO claiming a tape dispenser on behalf of X. The U.S. application was filed with a declaration under 37 CFR § 1.63 signed by X claiming foreign priority of the German patent application. In an Office action dated June 17, 1998, and setting a three month shortened statutory period for reply, a primary patent examiner properly rejected all the claims in the U.S. patent application as being anticipated under 35 U.S.C. § 102(a) by the disclosure in magazine articles describing how to make and use an identical tape dispenser. The articles were published in the United States in February 1997, and in Great Britain in March 1997. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the rejection?

- (A) On or before September 17, 1998, file a certified copy of the German application, and an English translation of the German application.
- (B) On or before September 17, 1998, file a certified copy of the German application, an English translation of the German application, and point out that the reference is no longer available as prior art.
- (C) File a reply on or before September 17, 1998, which argues that the reference cannot be used because the application inventor X filed in the German Patent Office antedates the article.
- (D) File an affidavit under 37 CFR § 1.132 signed by you stating that the reference cannot be used because the application which inventor X filed in the German Patent Office antedates the articles.
- (E) File a petition to have the Commissioner exercise his supervisory authority and withdraw the rejection stating that the reference cannot be properly used inasmuch as the declaration under 37 CFR § 1.63 makes clear that the application inventor X filed in the German Patent Office antedates the articles.

The correct answer is (B) and Petitioner chose answer (C). Answer (B) complies with proper PTO practice and procedure. To perfect a claim of foreign priority, the claim for benefit of foreign priority must be filed, along with a certified copy of the foreign application, 35 U.S.C. § 119(b), and an English translation of the foreign application, 37 C.F.R. § 1.55. Additionally, the practitioner must reply to the rejection by pointing out that the reference is no longer available as prior art. 37 C.F.R. § 1.111(b).

Petitioner contends that (C) is the most correct answer because it is the only answer which states that a “reply” was actually filed. Answer (B), however, which “point[s] out that the reference is no longer available as prior art” is sufficiently substantive to be a reply responsive to the rejection, and the answer choice directly speaks of a filing taking place. Accordingly, no grading error has been shown.

Question 41 reads as follows:

41. In regard to the Jones application, a complete Office action dated January 20, 1998, and setting a three month shortened statutory period for reply was mailed to the office of the attorney of record. The Office action contains rejections under 35 U.S.C. §§ 112 and 102. Considering separately the following different circumstances regarding the Office action, which course of action by the attorney complies with proper PTO practice and procedure and will correct the problem?

- (A) The Office action is in an envelope postmarked January 20, 1998, and was received in the attorney's office on Friday, January 30, 1998, due to delays in the U.S. Postal Service. The attorney should file and the PTO should grant a petition to restart the previously set reply period to run from the date of receipt of the Office action if the petition is filed on or before Friday, February 13, 1998, and the petition includes evidence showing the date of receipt, and the attorney's statement setting forth the date of receipt.
- (B) The Office action is in an envelope postmarked January 22, 1998, and was received in the attorney's office on Friday, January 30, 1998. The attorney should file and the PTO should grant a petition to restart the previously set reply period to run from the date of receipt of the Office action if the petition is filed on or before Friday, February 13, 1998, and the petition includes evidence showing the address on the Office action, a copy of the envelope which contained the Office action showing the postmark date, and the attorney's statement setting forth the date the Office action was received at the attorney's office and that the Office action was received in the postmarked envelope.
- (C) The Office action is in an envelope postmarked January 22, 1998, and was received in the attorney's office on Friday, January 30, 1998. The attorney should file and the PTO should grant a petition to restart the previously set reply period to run from the postmark date on the envelope if the petition is filed on April 30, 1998, with a reply to the Office action, and the petition includes evidence showing the address on the Office action, a copy of the envelope which contained the Office action showing the postmark date, and the attorney's statement setting forth the date the Office action was received at the attorney's office and that the Office action was received in the postmarked envelope.

- (D) A Notice of Abandonment dated August 19, 1998, is received in the attorney's office. The attorney should file and the PTO should grant a petition to revive the application as unavoidably abandoned where the petition is filed on September 24, 1998, contains the attorney's statement that the Office action was not revived by the attorney, and is accompanied by the appropriate petition fee and a proposed reply is not included.
- (E) None of the above.

The correct answer is (E) and Petitioner selected answer (D). The question asks in which of five distinct situations the course of action by the attorney complies with proper PTO practice and procedure and will correct the problem.

Answer (A) is incorrect. Although the petition was filed within two weeks of the date of receipt of the Office action, a substantial portion of the reply period (at least one month) had not elapsed on the date of receipt and the petition did not contain an explanation of how the presented evidence established the date of receipt of the Office action at the attorney's office. See MPEP § 710.06, petitions to reset a period for response due to late receipt of a PTO action.

Answer (B) is also incorrect. Although the postmark date is later than the mail date printed on the Office action, the reset period would run from the postmark date shown on the envelope, as opposed to the date of receipt of the Office action. See MPEP § 710.06, petitions to reset a period for response due to a postmark date later than the mail date printed on a PTO action.

Similarly, answer (C) is incorrect. Although the postmark date is later than the mail date on the Office action, the petition should have been filed within two weeks of the date on the Office action at the attorney's office. See MPEP § 710.06, both petition procedures.

Likewise, answer (D) is incorrect. A petition to withdraw the holding of abandonment should be filed. See MPEP § 711.02, petition to withdraw holding of abandonment based on failure to receive Office action. Also, the petition contains no showing that the delay was unavoidable, as required under 37 C.F.R. § 1.137(a)(3). Neither does a proposed reply to the Office action accompany the petition, as required by 37 C.F.R. § 1.137(a)(1).

Accordingly, answer (E) is the most correct answer because none of the answers complies with proper PTO practice and procedure to correct the problem. Petitioner contends that it is unclear from the facts in (D) “whether the statement by the attorney was just a summary or whether it was the entirety of the statement with respect to the unavoidable nature of the abandonment.” Petitioner contends that it is plausible that additional facts were submitted which established the unavoidable nature of the abandonment. Petitioner asserts that it is unclear whether a continuation application had ever been filed with respect to the abandoned application. Petitioner states that he chose (D) because of these ambiguities as well as because it was completely plausible that the facts given contemplated the required facts for compliance with 37 C.F.R. § 1.137(a). Finally, Petitioner notes that there is no statement in (D) that the delay was unintentional.

Petitioner’s arguments, however, assume facts not given, i.e., those which are required for compliance with 37 C.F.R. § 1.137(a). The examination instructions expressly warn to “not assume any additional facts not presented in the questions.” Accordingly, Petitioner’s arguments are directly contrary to the instructions. In view of the above, no grading error has been shown.

Question 43 reads as follows:

43. Five different situations are presented below wherein the attorney of record calls an error to the attention of the examiner. Which request (or lack of request) by the attorney, and reply by the examiner is not in accord with proper PTO practice and procedure?

- (A) An Office action dated February 11, 1998, and setting a three month shortened statutory period for reply was accompanied by a citation of references wherein a prior art patent was identified with an incorrect patent number. The attorney of record, on April 6, 1998, called the error to the attention of the examiner and requested that the examiner restart the reply period. The attorney should receive from the examiner a new citation of references correcting the error, a copy of the Office action redated, and a communication restarting the three month shortened statutory period for reply to run from the date the error is corrected.
- (B) A page of rejections is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the examiner set a new reply period. The attorney should receive from the examiner a complete, redated Office action setting a three month shortened statutory period for reply to run from the date the error is corrected.
- (C) A copy of a patent reference is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference, and a communication resetting the reply period to be a two month shortened statutory period running from the date the error is corrected.
- (D) A copy of a patent reference was omitted from an Office action dated April 16, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 19, 1998, called the error to the attention of the examiner, but did not request that the examiner set a new reply period. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated April 16, 1998.

- (E) A copy of a patent reference was omitted from an Office action dated March 9, 1998, which set a three month shortened statutory period for reply. The attorney of record, on July 14, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated March 9, 1998.

The correct answers are (A) and (B) and Petitioner chose answer (C). The question presents five different situations wherein the attorney of record calls an error to the attention of the examiner and asks for the one that is not in accord with proper PTO practice and procedure. Answers (A) and (B) are the most correct answers. MPEP § 710.06 provides that “[i]f the error is brought to the attention of the Office within the period for response set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for response, if requested to do so by the applicant, to substantially equal the time remaining in the response period.” Since the errors in both (A) and (B) were called to the examiner’s attention more than one month after the date of the Office action, the Office would set a new period of response “to substantially equal the time remaining in the response period.” Under this practice, the time remaining in the response periods for both (A) and (B) should be set at two months. As such, reference in both (A) and (B) to a “three month shortened statutory period” is not in accord with proper PTO practice and procedure. MPEP § 710.06 also provides that the Office will set a new period for reply only if requested by the attorney. The new period must be a minimum of one month, and it runs from the date the error was corrected. MPEP § 710.06.

Choice (C) is in accordance with proper PTO practice. MPEP § 710.06, first paragraph. Petitioner argues that answers (A) and (B) are “essentially the same . . . [and] neither could be selected as the most correct answer as required by the instructions to the examination.” However, answers (A) and (B) are not essentially the same. Unlike answer (B), answer (A) involves a new citation of references being provided to the attorney. Petitioner does not dispute that choices (A) and (B) comply with the PTO practice and procedure. Petitioner has not demonstrated why (A) or (B) are not correct.

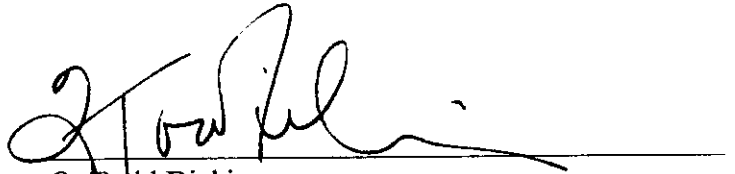
Petitioner contends that (C) is correct because the examiner did exactly what MPEP § 710.06 requires by not restarting the shortened statutory period for response. Petitioner states that inasmuch as neither (A) nor (B) could be selected over the other, he had to assume that other facts existed in (C) that made either the examiner’s or the applicant’s actions not in compliance with the MPEP § 710.06, making (C) the most correct answer. Petitioner’s argument, however, assumes facts not given and the examination instructions expressly warn to “not assume any additional facts not presented in the questions.” Accordingly, Petitioner’s argument is directly contrary to the instructions. In view of the above, no grading error has been shown.

ORDER

For the reasons given above, two points have been added to Petitioner's score in the Morning Section of the Examination. Therefore, Petitioner's score is adjusted to 62. This score is insufficient to pass the Morning Section of the Examination.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the request for a passing score on the Morning Section of the Examination is denied.

AUG 24 1999

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", is written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks